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PCT LEGAL ADMINISTRATION

In re Application of
KURT STEGE
Application No.: 10/562,413
PCT No.: PCT/EP04/06991
Int. Filing Date: 28 June 2004
Priority Date: 27 June 2003
Attorney's Docket No.: HI09032USU (11336.1236)
For: NAVIGATION METHOD AND
NAVIGATION SYSTEM

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: DECISION ON
:
: PETITIONS
:
: UNDER 37 CFR 1.137(b)
:
: & 1.47(b)
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This is a decision on applicant's petition under 37 CFR 1.137(b) to revive the application for patent unintentionally abandoned and renewed petition under 37 CFR 1.47(b), filed in the United States Patent and Trademark Office (USPTO) on 25 July 2011.

BACKGROUND

On 28 June 2004, applicant filed international application No. PCT/EP04/06991 which claimed a priority date of 27 June 2003, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 06 January 2005.

On 23 December 2005, within 30 months from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee.

On 4 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b) must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 06 November 2006, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). On 28 February 2007, the petition was dismissed indicating that Petitioner had not provided: (1) sufficient proof that the inventor was presented with a copy of the application papers (including specification, claims, and any drawings) in order to conclude that the inventor refuses or is unavailable to sign the application and (2) sufficient proof of proprietary interest in the subject matter to justify filing the application. A two month period of time for response was provided with extensions of time available under 37 CFR 1.136(a).

On 27 August 2007, applicant filed a request for an extension of time for a period of four months along with a response for the purposes of maintaining copendency of the application for

filing of a continuation-in-part application, which was filed on the same day.

On 05 January 2009, a Notice of Abandonment was mailed to applicant indicating that applicant had failed to timely reply to the Decision on petition mailed on 28 February 2007. On 15 June 2009, a request for withdrawal as attorney or agent and change of correspondence address was filed.

On 25 July 2011, more than 2 and a half years after abandonment of the application, applicant submitted the instant petition to revive and renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee required by law for revival of an unintentionally abandoned application (1.17(m)), (3) a statement that the "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional".

With respect to Item (1), a renewed petition under 37 CFR 1.47(b) accompanied applicant's petition to revive as the proper reply. However, applicant's renewed petition under 37 CFR 1.47(b) will be not be decided until the petition to revive is granted. With respect to Item (2), the petition included the petition fee of \$1620.

With regard to Item (3), applicant made the statement: "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." However, the petition under 37 CFR 1.137(b) to revive the application was not filed until 25 July 2011, more than two years after the expiration of the time period within which to respond to the decision on petition under 37 CFR 1.47(b).

Moreover, it is noted that applicant's submission on 27 August 2007 was not responsive to the decision but indicated: "In response to the decision dismissing our petition under 37 C.F.R. §1.47(b), dated April 28, 2007, Applicants are filing a four-month extension of time fee from the deadline to respond to the petition dismissal for the purpose of maintaining co-pendency of this application for the filing of a Continuation-in-Part application on August 27, 2007." This raises a question as to whether applicant intentionally abandoned the application in favor of a continuation-in-part application. It is noted that current counsel of record was not the attorney of record at the time of filing the request for an extension of time and continuation-in-part request.

While the inventor may not have intended to abandon the application, additional explanation by counsel of record at the time the response to the decision on petition was due and the request to file a continuation-in-part application occurred should be submitted.

The Office may require an applicant to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unintentional within the meaning of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b) where there is a question whether the entire delay was unintentional. See *Application of G*, 11 USPQ2d at 1380. It is appropriate for the Office to require further information as to how the delay in discovering the abandoned status occurred despite the exercise of due care and diligence on the part of applicant and applicant's representatives.

Item (3) is not satisfied. Accordingly, the granting of the petition under 37 CFR 1.137(b) for revival based on unintentional delay would not be proper at this time. The petition to revive under 37 CFR 1.137(b) is dismissed.

CONCLUSION

For the reasons discussed above, the petition to revive under 37 CFR 1.137(b) is **DISMISSED WITHOUT PREJUDICE**. The application remains **ABANDONED**.

The renewed petition under 37 CFR 1.47(b) is held in abeyance until the petition to revive is granted.

Any request for reconsideration on the merits of this decision must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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